



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,894	09/08/2000	Dennis Lee Rice	Rice-1	2805

7590 12/30/2003
Menotti J Lombardi
ITT Fluid Technology
10 Mountainview Road-North
Upper Saddle River, NJ 07458

EXAMINER

TON, ANABEL

ART UNIT PAPER NUMBER

2875

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/657,894

Applicant(s)

RICE, DENNIS LEE

Examiner

Anabel M Ton

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-19 is/are allowed.
- 6) ☒ Claim(s) 1-5, 10, 12 and 13 is/are rejected.
- 7) ☒ Claim(s) 6, 7 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton et al (6,315,435) and further in view of Williams (5,346,317).

3. Hamilton discloses the claimed invention except for disclosing a washer including a plurality of tabs to limit rotation of the first motor to a predetermined angle. Hamilton discloses a housing including a first end a window in the first end of the housing (front of lamp 2), a lamp disposed within the housing (14) so as emit light through said window a shaft, a positioning assembly secured within the housing, said positioning assembly including a first motor operable to rotate said housing in a first plane with respect to the shaft, and a second motor operable to pivot said housing in a second place with respect to the shaft, a first gear secured with respect to the shaft, and a second gear rotatable by the first motor wherein operation of the first motor causes the first and second gears to engage and rotate said assembly about the shaft in said first plane (figs 1-2), first and second planes are different, first and second planes are substantially different perpendicular to each other, the housing is substantially cylindrical, an elongated neck wherein the shaft passes through the neck into the housing. Williams discloses a disk

(washer), which biasingly engages a plate to restrain rotation of a shaft (col. 2 lines 15-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the instant invention by combining the searchlight of Hamilton with the teaching of the washer to restrain movement of Williams for the purpose of providing a shaft with a desired limited movement to a desired rotational positioning (rotational angle) for a desired application.

4. With regards to the rotation being limited to 380 degrees, it would have been obvious to one of ordinary skill in the art at the time the invention was made to limit rotation of the shaft to 380 degrees for the purpose of providing a searchlight that completes a full turn to illuminate a desired area. Furthermore, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Allowable Subject Matter

5. Claim 6,7 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 14-19 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter: The prior art cited does not disclose the following:

- A third gear being rotatable by the second motor whereby operation of the second motor causes the first section gear and the third gear to engage thereby causing the third gear to travel along the first section gear and pivot the housing in the second plane.
- A third gear fixed with respect to the positioning of the shaft and engaged by the first gear and a section gear secured with respect to the body and engaged by the third gear.

Response to Arguments

8. Applicant's arguments filed 10/27/03 have been fully considered but they are not persuasive. Applicant argues that the Hamilton reference does not disclose the positioning assembly secured within a housing. As shown in Hamilton and as acknowledged by applicant the first motor, gearbox, second motor, second gearbox and control housing are all mounted on base 14. One of the definitions for a housing is "a support for mechanical parts" which is the function of base 14 of the Hamilton reference. This satisfies applicant's limitation of the positioning assembly mounted within (all components are mounted within the boundaries of base/support 14) the housing. With regards to applicant's argument that the Williams reference does not teach a washer that limits rotation assembly to a predetermined angle, the examiner disagrees for the following reasons. As acknowledged by applicant, Williams has a plurality of radially extending fingers 56 which engage plate 38 to put a drag on the rotation of the plate. To limit the rotation of the plate to a desired angle does not differentiate from the teaching of Williams since the function of the extending fingers is to put a drag on the rotation of

the plate thus limiting the rotational angle of the assembly. Although the fingers are not limiting the rotation of the assembly to a desired specification of angularity, it has been held that where the general conditions of a claim are disclosed in the prior art (limiting the rotation angle of the plate, as taught by Williams) discovering optimum or workable ranges involves only ordinary skill in the art. *In re Aller*, USPQ 233.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anabel M Ton whose telephone number is (571) 272-2382. The examiner can normally be reached on 08:00-16:30.

Application/Control Number: 09/657,894
Art Unit: 2875

Page 6

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Anabel M Ton
Examiner
Art Unit 2875

AMT

A handwritten signature in black ink, appearing to read 'Anabel M Ton', is located below the printed name and title.